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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,217	12/12/2001	Thomas Raschke	Beiersdorf 754-KGB	8909

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EXAMINER	
WELLS, LAUREN Q	
ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/021,217	RASCHKE ET AL.	
	Examiner	Art Unit	
	Lauren Q Wells	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 April 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 1-9 are pending. The Amendment filed 4/7/03, Paper No. 7, added claim 9.

The Arguments filed 4/7/03, Paper No. 7, to the 35 USC 103 rejection in the previous Office Action are not persuasive to overcome the rejection. See below for details.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/37282. See US 6,503,518, which is an English language equivalent of WO 99/37282, for citation purposes.

The instant invention is directed toward a combination of one or more partially neutralized esters of monoglycerides and/or diglycerides of saturated fatty acids with citric acid and alpha-lipoic acid. The instant invention is further directed to applying such a composition to the skin.

US 581 is directed to cosmetic and dermatological compositions that comprise one or more partially neutralized esters of monoglycerides and/or diglycerides of saturated fatty acids with citric acid (abstract). US '518 discloses at column 4, lines 51-53 that the compositions preferably contain antioxidants. Lipoic acid is disclosed as a suitable antioxidant at column 4, lines 58-65. For glyceryl stearate citrate as a partially neutralized ester of monoglycerides and/or diglycerides of saturated fatty acids with citric acid within the instant claimed concentration

ranges and oil-in-water emulsions see the examples beginning at column 8. See also claims 1 and 2. For lotions and creams see col. 6, lines 34-41. For gels see col. 10, line 54.

US '518 does not explicity teach one composition comprising both one ore more partially neutralized esters of monoglycerides and/or diglycerides of saturated fatty acids with citric acid and alpha-lipoic acid or application to the skin.

US '518 does disclose that lipoic acid can be added to the composition for it's antioxidant properties. Nothing unobvious is seen in substituting the known claimed isomer for the compound of US '518 since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. It is well-known and common practice to apply cosmetic and dermatological compositions to the skin. Therefore, application of the composition to the skin as instantly claimed in not considered patentable over the prior art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the composition of US '518 using any isomer of lipoic acid and apply it to the skin expecting to obtain a cosmetic and dermatological composition with antioxidant properties.

Response to Arguments

Applicant argues, "The principle of In re Baird is relevant to this matter. Baird cautions against finding a specific claimed combination obvious, when it is merely suggested by a reference's shotgun disclosure of the entire art. The entirety of the reference(s) must suggest the claimed combination. . .Thus, as in von der Fecht, merely listing a component compound, without more, is not sufficient to establish prima facie case of obviousness. . .von der Fecht's

large number of antioxidants disclosed in the reference does not constitute sufficient suggestion for specifically selected lipoic acid for the claimed composition against a back group of hundreds of antioxidants". This argument is not persuasive. The Examiner respectfully points out that von der Fecht is not directed to a shotgun disclosure of the entire art of antioxidants. Von der Fecht broadly teaches that any known antioxidant can be utilized in his composition and then specifically teaches antioxidants that are preferably combined with his composition. Furthermore, in Col. 5, lines 33-34, von der Fecht specifically teaches that "For the purposes of the present invention, oil-soluble antioxidants can be used particularly advantageously", wherein lipoic acid is oil-soluble. Thus, the von der Fecht provides motivation teach lipoic acid as the antioxidant.

Regarding Applicant's arguments in reference to Merck v. Biocraft, the Examiner respectfully points out that Applicant has not provided any unexpected results. Thus, this argument is moot.

Applicant argues, "von der Fecht clearly states that antioxidants are unnecessary in using its composition". This argument is not persuasive. The Examiner respectfully points out that it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). Furthermore, the

Examiner respectfully points out that all of the examples of von der Fecht exemplify antioxidants.

Applicant argues, "Von der Fecht discloses a clear preference for distinct antioxidants". This argument is not persuasive. As stated above, the Examiner respectfully points out that the consideration of a reference is not limited to its preferred embodiments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for

the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
May 6, 2003

SREENI PADMANABHAN
PRIMARY EXAMINER

5/8/05